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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,836	04/28/2000	James Grossman	204,307	4613

7590 11/22/2004

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EXAMINER

LE, KHANH H

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/560,836

Applicant(s)

GROSSMAN, JAMES

Examiner

Khanh H. Le

Art Unit

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*MLJ*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on June 21, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 46-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Detailed Action***

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 21, 2004 has been entered.

Claims 11-14 and 40-45 have been canceled. New claims 46-48 have been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

3. **Claim 48 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As to claim 48, it is assumed this claim is dependent on claim 46 and not claim 1. Further it recites the limitation "said advertisement" There is insufficient antecedent basis for this limitation in claim 46 . Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

**5. Claims 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clevenstine, US 6053536 A in view of Sparks et al. , US 6167382 A.**

As to claims 46-48,

Clevenstine discloses subsidized mass mailers (see at least col. 3 lines 29-55) distributed to plural users, wherein the users include their own content onto the mass-mailer papers pre-printed with advertisement on the margins (see at least Figs. 3-4 and associated text).

Clevenstine does not teach assembling the mailers using an on-line system. However Sparks discloses customized assembly of the mail piece via Internet with layout template control (abstract, Fig. 1-13 and associated text);

Sparks discloses: establishing an Internet website for receiving/storing user identifying information, forming a database of registered users; electronically transmitting to registered users information that is formatted for printing (abstract, Fig. 1-13 and associated text).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the Sparks Internet document assembly into the Clevenstine method of assembling content onto sheets of marginally pre-printed ads to take advantage of the efficient Sparks' Internet document assembly method to do the ad targeting as taught by Clevenstine at col. 4 lines 1-17.

As to credits to an account of a registered user, the Clevenstine's user implicitly gets the benefit of a subsidy per mailer sheet. Further, subsidies received in terms of credits for predetermined monetary amounts to a beneficiary's credit account are well-known, thus increasing a user credit account based on those subsidies would have been obvious at the time of

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the invention to efficiently effect payment of subsidies as taught by Clevenstine while taking advantage of the e-payment technologies and the customer accounts as taught by Sparks.

As to selecting the "printed media", "printed media" is interpreted as the template containing the advertisements. Clevenstine discloses the template is selected based on the user criteria (see at least col. 3 lines 12-20; col. 4 lines 1-7) while Sparks discloses selection of the template by the registered user. Thus it would have been obvious to one skilled in the art at the time the invention was made to add Sparks's selection of the printed media by the user to the selection of mass-mailer template disclosed by Clevenstine to allow effective targeting of the ads to the user as taught by Clevenstine (see at least col. 4 lines 1-7 )

### Conclusion

6. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

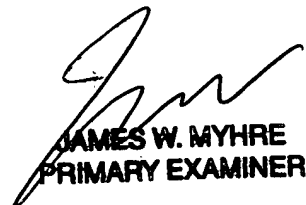
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

September 13, 2004

KHL

  
JAMES W. MYHRE  
PRIMARY EXAMINER